

Applicants: Watson et al.
Serial No.: 10/826,785
Filing Date: April 16, 2004
Docket No.: ZIL-308-1C

REMARKS

Reconsideration and allowance are respectfully requested.

Before entry of this Response, claims 1-9 and 18-29 were pending. In the Office Action, claims 1-9 and 18-29 were rejected. In the present Response, no claims are cancelled, added or amended. After entry of the Response, claims 1-9 and 18-29 are pending.

I. Claims 1-9 and 18-29

Claims 1-9 and 18-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimura (US Patent No. 6,211,797) in view of Nykanen (US Patent No. 6,728,774) (Office Action, p. 2, lines 10-11). To establish a *prima facie* case of obviousness, the Examiner must demonstrate that the references when combined teach all of the claimed limitations. In addition, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner has not established a *prima facie* case of obviousness because the combination of Kimura and Nykanen does not teach all of the claim elements. Moreover, the Examiner has pointed to no suggestion or motivation in either Kimura or Nykanen to combine the teaching of one with the teachings of the other.

A. Independent claims 1, 5, 18 and 26

Claim 1 recites a wireless transceiver that receives a communication containing instructions from an application set in a peripheral device. Claim 5 recites receiving a communication containing instructions from an application set in a peripheral device. Claim 18 recites a wireless transceiver that receives a communication from a second device and a detector that detects the configuration of an application contained on the second device. And claim 26 recites a wireless transceiver that receives a communication from a second

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device and means for enabling based on the configuration of an application in the second device. Thus, each of the claims 1, 5, 18 and 26 recites receiving a communication from a second device that has an application set with instructions or an application with a configuration. For example, in one embodiment, the second device is a printer, and the application is a software program for executing a printing function on the second device.

The Examiner's arguments in the final Office Action are substantially identical to the Examiner's arguments in the Office action dated January 6, 2006, except for the "Response to Arguments" section. Thus, the Examiner again acknowledges "that Kimura does not disclose that the communication contains instructions from an application set in the peripheral device" (Office Action, p. 3, lines 9-11) (emphasis added). And again the Examiner continues that "Nykanen is cited to show discovery process in which application set of other devices is discovered (see col. 4, lines 2-19)" (Office Action, p. 3, lines 11-12).

But the Examiner seems now to retract the argument that Nykanen teaches the discovery of an application set in another device. The Examiner seems now to admit that neither Kimura nor Nykanen teaches a communication from a second device that has an application set with instructions. Rather, the Examiner now relies on Official Notice that this claim limitation is "well known". The Examiner now argues:

"Even though Kimura does not specifically disclose instruction from application set in the peripheral device, it is well known that such instruction is communicated between the devices. Kimura discloses device comprising of various application sets, modulation schemes and protocols that communicates with plurality of other devices. It is therefore obvious that in order to optimize communication, appropriate protocol and/or application set and/or modulation schemes is selected based on the specific information provided by the devices (see col. 4, lines 11-16; col. 5, lines 64-67 to col. 6, lines 1-10; col. 7, lines 3-29, lines 61-67 to col. 8, lines 1-19 and lines 53-62). Nykanen is cited to show specific example of how such instruction may appear in response to communication initiated by initiator device (see col. 4, lines 8-20). Therefore, in establishing communication between different devices, it is well known to communicate specific device information (instruction)

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in order to optimize data transmission.” (Office Action, p. 11, lines 5-17) (emphasis added)

(1) Neither Kimura nor Nykanen teaches instructions of an application set.

The Examiner now seems to admit that neither Kimura nor Nykanen teaches discovering instructions of an application set on a peripheral device. The Examiner admits in the passage of the Office Action quoted above that Kimura does not specifically disclose this limitation, and that Nykanen is cited only to show how an instruction may appear. Therefore, the Examiner now argues that discovering instructions of an application set on a peripheral device is well known and obvious.

The Examiner refers to “various application sets, modulation schemes and protocols” (p. 11, line 8) and “appropriate protocol and/or application set and/or modulation schemes” (p. 11, lines 10-11). This use of the term “application set” by the Examiner is contrary to the use of the term in the claims. Similarly, the Examiner’s notion of communicating “specific device information (instruction)” is contrary to the use of the term “instruction” in the claims. Where the proper meaning is given to the claim term “instructions from an application set”, neither Kimura nor Nykanen teaches discovering instructions of an application set on a peripheral device.

Nowhere in the claims or in the specification are “instructions from an application set” described as being used to establish the underlying communication with a device. Instead, the recited “application set” relates to a function performed by a peripheral device, such as printing. For example, claim 9 recites “wherein the application set in the peripheral device comprises instructions to execute a print function”. And claim 19 recites, “wherein the second application version is a software program for executing a function on the second device”. The term “application set” as recited in the claims and as used in the specification is not a protocol or modulation scheme used to establish the underlying communication between different devices. Nor are the “instructions

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from an application set" used to optimize the underlying data transmission, as implied by the Examiner. The specification as amended states, "It should be understood that Ir communications 14 may be possible between a certain pair of appliances even if the app sets do not match. However, since the app sets may not 'understand' one another, some or all of the desired functionality might be lost or may produce erroneous operations." (Specification, p. 7, lines 5-8)

Applicants reiterate that neither Kimura nor Nykanen teaches discovering instructions of an application set on a peripheral device. None of the cited passages from Kimura (col. 4, lines 11-16; col. 5, lines 64-67 to col. 6, lines 1-10; col. 7, lines 3-29, lines 61-67 to col. 8, lines 1-19 and lines 53-62) teaches instructions from an application set on a peripheral device related to a function performed by the peripheral device. Although column 8 of Kimura does mention a printer, Kimura describes the data communication with the printer as opposed to instructions relating to functions of the printer. Column 8 states, "Data communication etc. can be conducted in the same fashion as the case of a printer conforming to the Centronics specification by connecting a cable for a parallel interface to these ports. . . . Especially, a printer capable of performing infrared communication can print by radio through the communication port 11 for emulating a parallel interface" (Kimura, col. 8, lines 6-19) (emphasis added). The term "application program" in Kimura does not teach an application as recited in the claims. Instead, Kimura uses the term "application program" to describe a program that switches modulation/demodulation schemes before data communications can be conducted with a second device. (See Kimura, col. 1, lines 36-40; col. 2, 7-17). The "application program" of Kimura is not related to the function, such as printing, performed by the second device.

The passage of Nykanen cited by the Examiner (col. 4, lines 8-20) does not concern instructions of an application set as recites by claims 1, 5, 18 and 26. The "application" recited in claims 1, 5, 18 and 26 is not used to establish a communication connection. Instead, instructions of the application are communicated between the device and the peripheral device once wireless

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communications have been established. The passage of Nykanen, however, does not relate to the functionality of an application on a peripheral device, such as printing. Instead, the cited passage relates to the process of discovering which peripheral devices can be communicated with. Nykanen does not teach the instructions of an application set on a peripheral device.

(2) The Examiner improperly applies Official Notice to teach "instructions of an application set"

Although the Examiner states that it is well known that "such instructions" are communicated between devices, the Examiner is referring to protocol and modulation schemes used to optimize the underlying data transmission. "Such instructions" are not instructions of an application set on a peripheral device.

To the extent that the Examiner is using Official Notice to teach the discovery of instructions of an application set related to a function performed by a peripheral device, the Examiner is asked to provide documentary evidence to support the Examiner's conclusion. For it to be appropriate for the Examiner to take Official Notice without supporting documentary evidence, the facts asserted must be of such common knowledge so as to be capable of instant and unquestionable demonstration as being well known. Moreover, when Official Notice is taken of a fact that is unsupported by documentary evidence, the underlying line of reasoning for the decision must be clear and unmistakable. The MPEP in §2144.03 states:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

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Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

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The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

Applicants maintain that the discovery of instructions of an application set related to a function performed by a peripheral device is not capable of instant and unquestionable demonstration as being well known.

(3) No motivation to combine Nykanen with Kimura.

The Examiner points to no suggestion or motivation in Kimura to combine the teachings of Kimura with the teachings of Nykanen to achieve all of the claim limitations. Such a motivation is understandably non-existent when all of the claim limitations are not taught by the references. A motivation to optimize the communication between devices would not have motivated one of skill in the art to combine teachings relating to the functionality of applications running on the devices. There is no suggestion in either Kimura or Nykanen to extend the inquiry as to the appropriate infrared scheme for communicating between a device and a peripheral device into an inquiry as to the appropriate version of software programs for executing functions on the peripheral device.

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Because the combination of Kimura and Nykanen does not disclose all of the elements of claims 1, 5, 18 and 26, and furthermore because there is no suggestion or motivation to combine Kimura and Nykanen, Kimura and Nykanen do not form the basis for a valid rejection under § 103(a). Reconsideration of the § 103(a) rejection and allowance of claims 1, 5, 18 and 26 are requested.

B. Dependent claims 2-4

Claims 2-4 depend from claim 1 and are allowable for at least the same reasons for which claim 1 is allowable. Allowance of claims 2-4 is requested.

C. Dependent claims 6-9

Claims 6-9 depend from claim 5 and are allowable for at least the same reasons for which claim 5 is allowable. Allowance of claims 6-9 is requested.

D. Dependent claims 19-25

Claims 19-25 depend from claim 18 and are allowable for at least the same reasons for which claim 18 is allowable. Allowance of claims 19-25 is requested.

E. Dependent claims 27-29

Claims 27-29 depend from claim 26 and are allowable for at least the same reasons for which claim 26 is allowable. Allowance of claims 27-29 is requested.

II. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the entire application (claims 1-9 and 18-29) is in condition for allowance. Applicants respectfully request that a timely Notice of Allowance be issued in this case. The

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undersigned can be contacted at (925) 621-2121 to discuss any aspect of this application.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By 
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Respectfully submitted,



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